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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,540	07/28/2003	Robert M. Lyden	L22.12-0051	3567
27367	7590	01/17/2006	EXAMINER	
WESTMAN CHAMPLIN & KELLY, P.A. SUITE 1400 - INTERNATIONAL CENTRE 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3319			SHRIVER II, JAMES A	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,540

Applicant(s)

LYDEN, ROBERT M.

Examiner

J. Allen Shriver

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 5,9,11,17,24 and 25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1-4,6,16 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 7,8,10 and 12-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/11/03; 11/17/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species 7 in the reply filed on October 24, 2005 is acknowledged. Examiner agrees with Applicant that Figures 26-34 and 54 all detail Species 7.
2. Claims 5, 9, 11 and 24-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 24, 2005.

Examiner does not agree with Applicant that claim 17 reads on the elected Species 7. Specifically claim 17 sets forth a "rocker adjustment device" which is shown in Figure 1 and 11-12 and set forth on page 25 of the Specification as represented by element 25. No where in the drawings or the specification does element 25 correspond to the species set forth in Figures 26-34 and 54, therefore, claim 17 has been withdrawn as being drawn to a non-elected species.

Claim Objections

3. Claim 1 is objected to because of the following informalities: In claim 1, in lines 3-5 and 9, the word "said" should be inserted before the phrase "locking mechanism assembly" to provide proper antecedent basis throughout the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Oh (US patent 6,422,578 B1).** Oh discloses a wheeled skate having a plurality of wheels (20) for rolling upon a skating surface comprising a chassis (18) comprising a longitudinal axis and a medial side, and a rotatable brake pad (32) mounted to a brake pad support, said rotatable brake pad being oriented to engage said skating surface supporting said wheeled skate when said medial side of said wheeled skate is inclined inwardly (See Fig. 3), wherein said rotatable brake pad is located exterior to said medial side of said chassis, and said rotatable brake pad rotates substantially parallel with respect to said longitudinal axis of said wheeled skate and independently of said plurality of wheels, when said medial side of said wheeled skate is inclined inwardly; [claim 20] wherein said rotatable brake pad comprises an oval brake pad.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chi (US Patent 6,729,629 B2) in view of Bryce (US Patent 6,331,007 B1).** Chi discloses a wheeled skate (B) and an article of footwear (A) comprising a locking mechanism assembly for removably securing said article of footwear to said wheeled skate (See Fig. 1), said locking

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mechanism assembly comprising a footwear portion of said locking assembly secured to said article of footwear (See Fig. 1), and a skate portion of said locking mechanism assembly secured to said wheeled skate, wherein said footwear portion of said locking mechanism assembly comprises a cleat portion of a cleat locking apparatus, whereby said article of footwear can be removably secured in functional relation to a bicycle cleat locking apparatus, and alternatively, to said wheeled skate comprising said skate portion of said locking mechanism assembly; **[claim 2]** wherein said footwear portion of said locking mechanism assembly and said skate portion of said locking mechanism assembly comprise compatible male and female components (See Fig. 1); and **[claim 6]** further including fastening means for removably securing the rear foot of said article of footwear to said wheeled skate. Chi does not expressly state that the cleat locking mechanism can be secured in functional relation to a bicycle pedal. However, there are numerous types and configurations of clip-less bicycle pedal systems and it would be within the requisite skill level to provide a corresponding bicycle cleat locking mechanism to work properly with the locking assembly provided on the footwear disclosed in Chi. Additionally, in Bryce, which sets for a locking mechanism assembly, “it is to be understood that the invention [a locking mechanism assembly] could have application with other items of sports equipment such as bicycles.” See column 1, lines 10-12. Therefore, it would have been obvious to a person of ordinary skill in this art to secure the locking assembly provided on the footwear disclosed in Chi with a bicycle pedal cleat as taught in Bryce. The motivation for doing so would have been to allow the user to use the footwear disclosed in Chi with numerous sports equipment.

Regarding claim 3, the combination of Chi and Bryce disclose wherein the locking apparatus of the footwear, skate and bicycle cleat are hermaphroditic.

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8. **Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chi (US Patent 6,729,629 B2) and Bryce (US Patent 6,331,007 B1) as applied to claim 1 above, and further in view of Ricci (US Patent 6,497,420 B2).** The combination of Chi and Bryce disclose the wheeled skate as set forth above, but does not disclose wherein the skate is in-lined. Ricci discloses a skate with an in-line configuration. At the time of the invention, it would have been obvious to a person of ordinary skill in this art to provide an in-lined skate configuration for the skate disclosed in Chi in view of the teaching of Ricci. The motivation for doing so would have been to provide a skate with greater maneuverability.

Regarding claim 18, the combination of Chi and Bryce discloses the wheeled skate as set forth above, but does not disclose wherein said longitudinal length of said wheeled skate is adjustable. Ricci discloses a skate wherein the longitudinal length of said wheeled skate is adjustable. At the time of the invention, it would have been obvious to a person of ordinary skill in this art to modify the skate disclosed in Chi to allow longitudinal adjustment as taught by Ricci. The motivation for doing so would have been to allow numerous users to use the skate.

9. **Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oh (US patent 6,422,578 B1).** Oh discloses the wheeled skate as set forth above, but does not disclose wherein said rotatable brake pad is positioned at said middle of said chassis on said medial side. The court has held that rearrangement of parts, which would not have modified the operation of the device, is an obvious matter of design choice. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In this case, it would have been obvious to a person of ordinary skill in this art to place the brake pad in the middle of the chassis on the medial side in the skate disclosed in Oh. The motivation for doing so would have been to allow the skate to be more balanced when tilted.

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10. **Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chi (US Patent 6,729,629 B2) and Bryce (US Patent 6,331,007 B1) as applied to claim 1 above, and further in view of Stevenson (US Patent 3,224,785).** The combination of Chi and Bryce disclose the wheeled skate as set forth above, but does not disclose a removable front brake pad extending at least to the anterior side of said wheeled skate, and also a removable rear brake pad extending at least to the posterior side of said wheeled skate. Stevenson discloses providing a front and rear removable brake pad extending to the anterior and posterior of the skate, respectively. At the time of the invention, it would have been obvious to a person of ordinary skill in this art to provide a front and rear removable brake on the skate disclosed in Chi in view of the teaching of Stevenson. The motivation for doing so would have been to allow the skater to slow the skate using a brake positioned on either the front or back of the skate.

Allowable Subject Matter

11. Claims 7-8, 10 and 12-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 22-23 are allowed over the prior art.

Conclusion

13. The prior art made of record in the accompanying PTO Form 892 and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Allen Shriver whose telephone number is (571) 272-6698. The examiner can normally be reached on Monday, Wednesday and Thursday 6:30 am-6:00 pm and Tuesday 6:30 am-11:00 am.

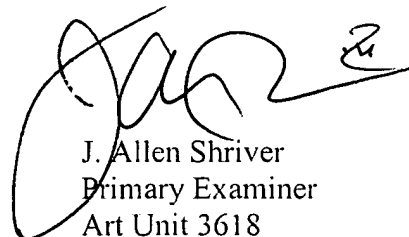
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris P. Ellis can be reached on (571) 272-6914. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

As of May 1, 2003, any response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to: (571) 273-8300 (for formal communications intended for entry). (571) 273-6698 (for informal communications directly to the Examiner).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Allen Shriver
Primary Examiner
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